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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,614	07/19/2000	Makoto Kukita	193236US2	2165
22850	7590	11/18/2003		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SHENG, TOM V	
			ART UNIT 2673	PAPER NUMBER 13

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/619,614

Applicant(s)

KUKITA, MAKOTO

Examiner

Tom V Sheng

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 17-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Examiner's Note*

In light of the withdrawal of the previous final office action, the amendment filed on 6/30/03 is not entered.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 8-11, and 15-16 rejected under 35 U.S.C. 102(b) as being anticipated by Young (US Patent 5382962).

Consider claims 1 and 8. Young teaches a handle/controller for a handheld computer (figures 1, 2, 3), comprising a main body (handheld computer 1 and base unit 2) having a display unit (see figure 1) on a surface thereof; and a holding unit (handle/controller 4) protruding substantially perpendicular (perpendicular to the bottom surface of the handheld computer/base unit) from the main body for holding the portable electronic apparatus (by resting on the palm of a hand) and including a pointing device (cursor ball 5L or 5R) and switches (action switches 6L or 6R) configured to be operated by a same hand holding the holding unit (see column 1, line 60 - column 2, line 6).

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As for claims 2 and 9, Young's cursor ball (5L or 5R) reads on claimed trackball pointing device configured to perform pointing operations including moving a cursor displayed on said display unit (see column 2, lines 10-16).

As for claims 3 and 10, Young's action switch (6L or 6R) reads on claimed said switches comprises click devices configured to set or cancel instructions pointed to by said pointing device (see column 2, lines 17-19).

As for claims 4 and 11, Young's handle/controller 4 is detachable and thus reads on claimed said holding unit is removable from main body (see column 2, lines 20-30).

As for claims 15 and 16, Young's handle/controller 4 is for a handheld computer that reads on claimed portable computer.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young.

As for claims 5 and 12, Young is silent regarding claimed said holding unit is configured to store batteries used to power said portable electronic apparatus. On the other hand, Young teaches batteries storage in side legs 3, inherently for powering his handheld computer in the field. One of ordinary skill in the art would recognize that the

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batteries could just as easily be installed in the handle/controller 4; moreover, with the batteries in the handle/controller 4, the user would have a more balanced feel holding the computer. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate batteries into the handle/controller, thus providing batteries powered operation in the field and with good balance holding the computer.

5. Claims 6, 7, 13, 14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young as applied to claims 1 and 8 above, and further in view of Hartigan (US Patent 6035491).

Consider claims 6, 7, 13, and 14. Young teaches a holding unit including a pointing device and switches operable by a same hand. However, Young does not teach that the holding unit is foldable toward a side of the main body, or that power would be supplied/cut-off based on the position of the holding unit. On the other hand, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Young's holding unit to be foldable and further having power-on when unit is unfolded and power-off when unit is folded, since some people would prefer to hold the holding unit in an upright fashion when operating the portable electronic apparatus. Further, it would be naturally desired to turn off the apparatus when the holding unit is folded, since the user is not going to use the apparatus in that instance.

As a support, Hartigan shows a foldable device (10) having a flip portion (14) housing a display (18). Naturally, when the flip portion is open, the user is intending to

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use the device, and when the flip portion is closed, the user is not going to use the device (column 2, lines 1-37). This is similarly true with a foldable cell phone.

As for claims 19 and 20, Young's attachment screw 7 is a connector configured to connect the holding unit (handle/controller 4) to the main body (handheld computer 1 and base unit 2). The holding unit is attached and not separated from the main body.

However, Young as modified by Hartigan, in order to allow the holding unit to fold and unfold, would have a connector that is hinge-like and would thus be separated from the main body.

#### ***Allowable Subject Matter***

6. Claims 17-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: none of prior arts of record teaches the recitation "wherein the holding unit includes a grip to be grasped at least with a palm of said one hand such that when a user holds the holding unit with said one hand, the palm of said one hand holding the holding unit is also substantially perpendicular to the main body" as well as other limitations of claims 17 and 18 not cited.

#### ***Response to Arguments***

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8. Regarding independent claims 1 and 8, applicant argues that Young's handle/controller is parallel to the main body 2. However, examiner disagrees because the handle/controller still protrudes substantially perpendicular from the main body 2 as shown on figure 2.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Tom Sheng  
November 3, 2003

  
KENT CHANG  
PRIMARY EXAMINER